

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellants: HAWKINS, Bret David, et al.
Serial Number: 10/577,267
Atty. Dkt: PU030298
Filing Date: April 26, 2006
For: AUTOMATIC DISPLAY OF NEW PROGRAM INFORMATION
DURING CURRENT PROGRAM VIEWING
Art Unit: 2425
Examiner: CHOKSHI, Pinkal R.

APPEAL BRIEF

**Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

Sir:

In response to the final Office Action dated May 9, 2011 and the Advisory Action dated July 19, 2011, and further to the Notice of Appeal filed on September 9, 2011, Appellants hereby submit an Appeal Brief in accordance with 37 C.F.R. §41.37 for the above-referenced application.

I. Real Party in Interest

The real party in interest is THOMSON Licensing S.A., 46 Quai A. Le Gallo, F-92100 Boulogne-Billancourt, France.

II. Related Appeals and Interferences

There are no prior or pending appeals, interferences, or judicial proceedings known to Appellants, the Appellants' legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 21-40 are pending in this application, and are rejected. Claims 1-20 are cancelled. The rejection of claims 21-40 is being appealed.

IV. Status of Amendments

No amendment subsequent to the final rejection of May 9, 2011 has been filed.

V. Summary of Claimed Subject Matter

Independent claim 21 recites a method for operating a television apparatus (see, for example, flowchart 600 of FIG. 7), the method comprising steps of:

tuning a channel (see, for example, page 17, lines 12-13 and step 602 of FIG. 7);

receiving an updated program guide from a broadcaster while said channel is tuned, wherein said updated program guide is provided from said broadcaster without being requested by said television apparatus (see, for example, page 17, lines 26-29 and step 612 of FIG. 7);

in response to receiving said updated program guide, determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned (see, for example, page 17, lines 29-30 and step 614 of FIG. 7);

in response to determining that said banner is currently displayed while said channel is tuned, performing a first function while said channel is tuned (see, for example, page 17, line 30 to page 18, line 1 and step 616 of FIG. 7); and

in response to determining that said banner is not currently displayed while said channel is tuned, performing a second function different from said first function while said channel is tuned (see, for example, page 18, lines 1-2 and step 610 of FIG. 7).

Independent claim 28 recites a television apparatus, comprising:

means (see, for example, element 1105 of FIG. 2, element 15 of FIG. 4 or element 301 of FIG. 5) for tuning a channel (see, for example, page 17, lines 12-13 and step 602 of FIG. 7);

means (see, for example, element 1101 of FIG. 2, element 10 of FIG. 4 or element 317 of FIG. 5) for receiving an updated program guide from a broadcaster while said channel is tuned, wherein said updated program guide is provided from said broadcaster without being requested by said television apparatus (see, for example, page 17, lines 26-29 and step 612 of FIG. 7); and

means (see, for example, element 1112 of FIG. 2, element 115 of FIG. 4, or element 315 of FIG. 5 and page 17, lines 3-6) for determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned in response to receiving said updated program guide (see, for example, page 17, lines 29-30 and step 614 of FIG. 7); and wherein:

if said determining means determines that said banner is currently displayed while said channel is tuned, a first function is performed while said channel is tuned (see, for example, page 17, line 30 to page 18, line 1 and step 616 of FIG. 7); and

if said determining means determines that said banner is not currently displayed while said channel is tuned, a second function different from said first function is performed while said channel is tuned (see, for example, page 18, lines 1-2 and step 610 of FIG. 7).

Dependent claim 29 recites the television apparatus of claim 28, further comprising means (see, for example, element 1112 of FIG. 2, element 115 of FIG. 4, or element 315 of FIG. 5 and page 17, lines 3-6) for requesting said updated program guide from said broadcaster a predetermined time period before a detected end time of a currently tuned program on said channel (see, for example, page 17, lines 21-24 and step 608 of FIG. 7).

Independent claim 35 recites a television apparatus, comprising:

a tuner (see, for example, element 1105 of FIG. 2, element 15 of FIG. 4 or element 301 of FIG. 5) operative to tune a channel (see, for example, page 17, lines 12-13 and step 602 of FIG. 7);

an input (see, for example, element 1101 of FIG. 2, element 10 of FIG. 4 or element 317 of FIG. 5) operative to receive an updated program guide from a broadcaster while said channel is tuned, wherein said updated program guide is provided from said broadcaster without being requested by said television apparatus (see, for example, page 17, lines 26-29 and step 612 of FIG. 7); and

a controller (see, for example, element 1112 of FIG. 2, element 115 of FIG. 4, or element 315 of FIG. 5 and page 17, lines 3-6) operative to determine if a banner advertising a future program on said channel is currently displayed while said channel is tuned in response to reception of said updated program guide (see, for example, page 17, lines 29-30 and step 614 of FIG. 7); and wherein:

if said controller determines that said banner is currently displayed while said channel is tuned, a first function is performed while said channel is tuned (see, for example, page 17, line 30 to page 18, line 1 and step 616 of FIG. 7); and

if said controller determines that said banner is not currently displayed while said channel is tuned, a second function different from said first function is performed while said channel is tuned (see, for example, page 18, lines 1-2 and step 610 of FIG. 7).

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are presented for review in this appeal:

A. The rejection of claims 28 and 29 under 35 U.S.C. §112, second paragraph;

B. The rejection of claims 21, 23-25, 27-28, 30-32, 35 and 37-38 under 35 U.S.C. §103(a) based on the proposed combination of U.S. Patent No. 6,536,041 issued to Knudson et al. (hereinafter, "Knudson"), U.S. Patent Publication No. 2003/0083533 by Gerba et al. (hereinafter, "Gerba") and U.S. Patent Publication No. 2002/0194599 by Mountain (hereinafter, "Mountain");

C. The rejection of claims 22, 29 and 36 under 35 U.S.C. §103(a) based on the proposed combination of Knudson, Gerba, Mountain and U.S. Patent Publication No. 2004/0078817 by Horowitz et al. (hereinafter, "Horowitz"); and

D. The rejection of claims 26, 33-34 and 39-40 under 35 U.S.C. §103(a) based on the proposed combination of Knudson, Mountain, Gerba, Horowitz and U.S. Patent No. 6,396,531 issued to Gerszberg (hereinafter, "Gerszberg").

VII. Argument

A. Patentability of Claims 28 and 29 under 35 U.S.C. §112, Second Paragraph

The rejection of claims 28 and 29 under 35 U.S.C. §112, second paragraph should be reversed for at least the following reasons.

In the final Office Action of May 9, 2011, the Examiner alleges that the claimed "means for determining" recited in claim 28 and "means for requesting" recited in claim 29 invoke 35 U.S.C. §112, sixth paragraph, but the written description fails to disclose corresponding structure, material or acts for the claimed functions. While the Examiner ostensibly acknowledges that the functions of the aforementioned "means" are performed by a "CPU/processor", he alleges that "there is no corresponding algorithm disclosed for these functions." (see pages 3-4 of the final Office Action).

In response, Appellants note that the claimed functions of the "means for determining" and "means for requesting" correspond to various steps of the control

program/algorithm 600 represented in the flowchart of FIG. 7 of Appellants' specification. Moreover, Appellants' specification clearly indicates that the various steps of the control program/algorithm 600 represented in the flowchart of FIG. 7 "... may be executed by either the CPU 1112 of FIG. 2, the controller 115 of FIG. 4, or the ARM microprocessor 315 of FIG. 5 to implement the features according to the present invention" (see page 17, lines 3-6).

Accordingly, it is clear from Appellants' specification that the claimed "means for determining" and "means for requesting" may correspond to CPU 1112 of FIG. 2, controller 115 of FIG. 4, or ARM microprocessor 315 of FIG. 5, and that the "corresponding algorithm" for the functions of these "means" is provided by the control program/algorithm 600 in FIG. 7 of Appellants' specification.

In view of the foregoing clarification, Appellants submit that claims 28 and 29 are definite under 35 U.S.C. §112, second paragraph, and reversal of the rejection is respectfully requested.

B. Patentability of Claims 21, 23-25, 27-28, 30-32, 35 and 37-38 under 35 U.S.C. §103(a)

The rejection of claims 21, 23-25, 27-28, 30-32, 35 and 37-38 under 35 U.S.C. §103(a) based on the proposed combination of Knudson, Gerba and Mountain should be reversed for at least the following reasons.

Independent claim 21 recites:

"A method for operating a television apparatus, the method comprising steps of:
tuning a channel;
receiving an updated program guide from a broadcaster while said channel is tuned, wherein said updated program guide is provided from said broadcaster without being requested by said television apparatus;

in response to receiving said updated program guide, determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned;

in response to determining that said banner is currently displayed while said channel is tuned, performing a first function while said channel is tuned; and

in response to determining that said banner is not currently displayed while said channel is tuned, performing a second function different from said first function while said channel is tuned." (emphasis added)

As indicated above, independent claim 21 recites a method for operating a television apparatus. According to the claimed method, a channel is first tuned. Thereafter, a unique combination of steps is performed while that same, single channel is tuned. First, while the channel is tuned, the television apparatus receives an updated program guide from a broadcaster, wherein the updated program guide is provided (i.e., "pushed") from the broadcaster without being requested by the television apparatus. In response to receiving the updated program guide, the television apparatus determines if a banner advertising a future program on the channel is currently displayed while the channel is tuned. In response to determining that the banner is currently displayed while the channel is tuned, the television apparatus performs a first function while the channel is tuned. In response to determining that the banner is not currently displayed while the channel is tuned, the television apparatus performs a second function different from the first function while the channel is tuned. Independent claims 28 and 35 recite features similar to independent claim 21.

None of the cited references, whether taken individually or in combination, discloses or suggests the desirability of the unique combination of steps/features/elements recited by independent claims 21, 28 and 35. Among other things, the Examiner's proposed combination of references completely ignores the fact that the aforementioned steps of the claimed invention are all performed while one single channel is tuned.

On page 6 of the final Office Action of May 9, 2011, the Examiner alleges:

"As to 'in response to receiving said updated program guide, determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned' Knudson discloses (col. 1, lines 33-35; col. 8, line 39-col. 9, line 37) that the receiving device receives real time data (updated program guide) from the data source, which is used to display real time data on sports scores with the EPG data, where the guide continually display up-to-the-minute scores with the program listings in real time as represented in Fig. 3.

Knudson meets all the limitations of the claim except 'determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned.' However, Gerba discloses (¶187) that the determination is made whether the banner is displayed as represented in Fig. 32A (element 952)." (emphasis added)

As indicated above, the Examiner selectively relies on isolated elements of Knudson and Gerba for allegedly disclosing portions of the individual claim step: "in response to receiving said updated program guide, determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned" recited by independent claim 21 (and similarly recited by independent claims 28 and 35). In particular, the Examiner ostensibly relies on the primary reference, Knudson, only for the language "in response to receiving said updated program guide", whereas Gerba is ostensibly relied upon for the language "determining if a banner ... is displayed".

However, Gerba teaches that the step of "determining if a banner ... is displayed" (i.e., step 952 of FIG. 32A) is performed only in response to a channel change event (see paragraph [0187]). Accordingly, the proposed combination of Knudson and Gerba necessarily involves the tuning of at least two different channels. This aspect of the proposed combination is completely contrary to the aforementioned principles of the present invention where the claimed steps are all performed while one single channel is tuned. As such, the proposed combination of Knudson and Gerba fails to disclose or suggest each and every feature of the claimed invention relied upon by the Examiner.

In addition to the aforementioned isolated teachings of Knudson and Gerba, the Examiner also relies on Mountain for disclosing a "banner advertising a future program" (see page 7 of the final Office Action). That is, the Examiner ostensibly relies on isolated teachings of all three cited references in an attempt to meet the claim language of just a single claim step (i.e., the step "in response to receiving said updated program guide, determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned" of claim 21).

Here, Appellants note that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Accordingly, the mere fact that certain aspects of the claimed invention may have been known, independently, in the prior art, is not sufficient to sustain an obviousness rejection.

Moreover, the mere fact that a prior art device could (in hindsight) be modified to produce a claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such a modification. See, for example, *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989) ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to the form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'") and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In this case, one of ordinary skill in the art would in no way consider the proposed combination and modification of references desirable since the resulting combination would defeat the aforementioned principles of the present invention where the claimed steps are all performed while one **single** channel is tuned.

Moreover, the proposed, selective combination of isolated elements from three different references in an effort to meet the claim language of just a single claim step (i.e., the step "in response to receiving said updated program guide, determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned" of claim 21) strongly suggests that the instant rejection is the product of impermissible hindsight reconstruction based on selectively picking and choosing isolated elements of various references in an effort to meet Appellants' claim language. Such a rejection is clearly improper under 35 U.S.C. §103.

Therefore, for at least the foregoing reasons, Appellants submit that claims 21, 23-25, 27-28, 30-32, 35 and 37-38 are patentable under 35 U.S.C. §103(a) over the proposed combination of Knudson, Gerba and Mountain, and reversal of the rejection is respectfully requested.

C. Patentability of Claims 22, 29 and 36 under 35 U.S.C. §103(a)

The rejection of claims 22, 29 and 36 under 35 U.S.C. §103(a) based on the proposed combination of Knudson, Gerba, Mountain and Horowitz should be reversed for at least the following reasons.

Horowitz is unable to remedy the deficiencies of Knudson, Gerba and Mountain pointed out above in connection with independent claims 21, 28 and 35 (from which claims 22, 29 and 36 respectively depend).

Accordingly, Appellants submit that claims 22, 29 and 36 are patentable under 35 U.S.C. §103(a) over the proposed combination of Knudson, Gerba, Mountain and Horowitz, and reversal of the rejection is respectfully requested.

D. Patentability of Claims 26, 33-34 and 39-40 under 35 U.S.C. §103(a)

The rejection of claims 26, 33-34 and 39-40 under 35 U.S.C. §103(a) based on the proposed combination of Knudson, Mountain, Gerba, Horowitz and Gerszberg should be reversed for at least the following reasons.

Gerszberg is unable to remedy the deficiencies of Knudson, Mountain, Gerba and Horowitz pointed out above in connection with independent claims 21, 28 and 35, and dependent claims 22, 29 and 36 (from which claims 26, 33-34 and 39-40 ultimately depend).

Accordingly, Appellants submit that claims 26, 33-34 and 39-40 are patentable under 35 U.S.C. §103(a) over the proposed combination of Knudson, Mountain, Gerba, Horowitz and Gerszberg, and reversal of the rejection is respectfully requested.

If not already charged, please charge the fee for this Appeal Brief, and credit any overpayment, to Deposit Account 07-0832.

Respectfully submitted,

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Date: October 25, 2011

VIII. Claims Appendix

21. A method for operating a television apparatus, the method comprising steps of:

tuning a channel;

receiving an updated program guide from a broadcaster while said channel is tuned, wherein said updated program guide is provided from said broadcaster without being requested by said television apparatus;

in response to receiving said updated program guide, determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned;

in response to determining that said banner is currently displayed while said channel is tuned, performing a first function while said channel is tuned; and

in response to determining that said banner is not currently displayed while said channel is tuned, performing a second function different from said first function while said channel is tuned.

22. The method of claim 21, further comprising a step of requesting said updated program guide from said broadcaster a predetermined time period before a detected end time of a currently tuned program.

23. The method of claim 21, wherein said banner includes at least one of: a title of said future program, a starting time of said future program, and a duration of said future program.

24. The method of claim 23, wherein said future program is a next program on a currently tuned channel.

25. The method of claim 21, wherein said first function includes updating said currently displayed banner with new information based on said updated program guide.

26. The method of claim 22, wherein said predetermined time period is selected by a user of said television apparatus.

27. The method of claim 21, wherein said second function includes enabling display of said banner based on said updated program guide.

28. A television apparatus, comprising:

means for tuning a channel;

means for receiving an updated program guide from a broadcaster while said channel is tuned, wherein said updated program guide is provided from said broadcaster without being requested by said television apparatus; and

means for determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned in response to receiving said updated program guide; and wherein:

if said determining means determines that said banner is currently displayed while said channel is tuned, a first function is performed while said channel is tuned; and

if said determining means determines that said banner is not currently displayed while said channel is tuned, a second function different from said first function is performed while said channel is tuned.

29. The television apparatus of claim 28, further comprising means for requesting said updated program guide from said broadcaster a predetermined time period before a detected end time of a currently tuned program on said channel.

30. The television apparatus of claim 28, wherein said banner includes at least one of: a title of said future program, a starting time of said future program, and a duration of said future program.

31. The television apparatus of claim 28, wherein said future program is a next program on said channel.

32. The television apparatus of claim 28, wherein said first function includes updating said currently displayed banner with new information based on said updated program guide.

33. The television apparatus of claim 29, wherein said predetermined time period is selected by a user of said television apparatus.

34. The television apparatus of claim 33, wherein said second function includes enabling display of said banner based on said updated program guide.

35. A television apparatus, comprising:

a tuner operative to tune a channel;

an input operative to receive an updated program guide from a broadcaster while said channel is tuned, wherein said updated program guide is provided from said broadcaster without being requested by said television apparatus; and

a controller operative to determine if a banner advertising a future program on said channel is currently displayed while said channel is tuned in response to reception of said updated program guide; and wherein:

if said controller determines that said banner is currently displayed while said channel is tuned, a first function is performed while said channel is tuned; and

if said controller determines that said banner is not currently displayed while said channel is tuned, a second function different from said first function is performed while said channel is tuned.

36. The television apparatus of claim 35, further comprising means for requesting said updated program guide from said broadcaster a predetermined time period before a detected end time of a currently tuned program on said channel.

37. The television apparatus of claim 35, wherein said banner includes at least one of: a title of said future program, a starting time of said future program, and a duration of said future program.

38. The television apparatus of claim 35, wherein said first function includes updating said currently displayed banner with new information based on said updated program guide.

39. The television apparatus of claim 36, wherein said predetermined time period is selected by a user of said television apparatus.

40. The television apparatus of claim 39, wherein said second function includes enabling display of said banner based on said updated program guide.

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IX. Evidence Appendix

None.

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X. Related Proceedings Appendix

None.